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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/379,699	08/24/1999	JEFFRY JOVAN PHIYAW	PHLY-24-747	1610

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EXAMINER

ZIA, SYED

ART UNIT PAPER NUMBER

2131

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/379,699

Applicant(s)

PHIYAW ET AL.

Examiner

Syed Zia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Original application contained Claims 1-9. Applicant previously amended Claim 1, and left unchanged Claims 2-9. Therefore, Claims 1-9 are pending for further consideration.

Applicant's submission filed on September 28, 2004 has been entered.

Specification

1. The examiner suggests the Applicant's to remove the TITLE of the invention from the Abstract on page 52 accordingly.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, recites the limitation "the network instructional code" in line number 9.

Claims 1, 8 recite the limitation " the instructional code " in line number 14, and line 3 respectively.

There is insufficient antecedent basis for these limitations in the claims.

Response to Arguments

1. Applicant's arguments filed September 28, 2004 have been fully considered but they are not persuasive because of the following reasons:

Regarding Claims 1-9 applicant agreed that in the cited prior art there is some information as to an "automatic" operation wherein information is sent back to the user computer to provide for a "jump" operation controlled by the user computer, and applicant argued that in the cited prior art "*the user computer that determines what to do with the information received because there is no instruction code to command the user computer to jump to a location*".

This is not found persuasive. CPA (Cited Prior Art) [Hudetz et al., US Patent No. 5,978,773] clearly teaches a local computer (user) that is provided with a bar code (i.e. product code) reader. This reader reads bar codes from products in a standard product code format, such

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as UPC, ISBN, or EAN. The bar code is input to an Internet browser on the user computer. The computer accesses a *service provider* (i.e. intermediate server) and forwards the bar code value to server. The server uses the bar code to access a database. From this is retrieved an Internet address and this is used to connect the user computer to that site (manufacturer, or advertiser) as strictly defined in the database (such as product and site relationship). This database is strictly under the control of server (intermediate site), and only server has authority and control to define and develop the relationship between product code and corresponding Internet site(s) based on the business rules developed by the administrator of server (intermediate site). The Internet site returned by server (intermediate site) may have information about the product, or be a site identified by the product. Therefore, in CPA the server (intermediate node) controls every connection, and the user computer does not have any control in defining the manufacturer or advertiser site(s) based on product code, and only server (intermediate node) guarantee the connection accordingly (based on business rule).

Also as described in detail in the applicant disclosure, that a resident program (wand program) prepare the user computer to display user selected information (received from intermediate server based on product code scanned by the user) as well as advertisement related to product by transmitting back by the PC 302 a packet to advertisement server 312 to obtain the advertised information from distributor site 1616, which applicant claimed in claim 1 as the "network instructional code". Similarly, CPA provides a mechanism to receive and display product and added value information based on the instruction code packet transmitted from the server (intermediate server) by having controlling and displaying mechanism using HTML code

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and function resided on user computer to retrieve the information from manufacturer or advertiser sites.

As a result, CPA does implement a method for automatic response to the step of extracting product code and associating this with network routing to assemble message packet for transmission, and receiving and displaying product and added value information from distributor and advertiser site based on the packet of information transmitted from server and user computer query regarding a product.

Therefore, the examiner asserts that cited prior art does teach or suggest the subject matter as recited in independent claim 1. Dependent claims 2-9 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in the this office action. Accordingly, rejections for claims 1-9 are respectfully maintained.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

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122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hudetz et al., US Patent No. (5,978,773).

2. Regarding Claim 1 Hudetz teaches a system for using identification codes [product codes] found on ordinary articles of commerce to access remote computers on a network and a method for utilizing a product code (Fig.1 Item 46) having product information contained therein for interfacing (Fig.1 Item 50) a user node (Fig.1 Item 28) to a remote node (Fig.1 Item 24) over a network (Fig.1 Item 20), comprising the steps of

- extracting (i.e. scanning, reading) (Fig.1 Item 44) the product information from the product code at the user node(Fig.1 Item 28), which product code is disposed on or in close association with an associated product (Fig. 1 and 3, col. 6 line 20 to line 32, and col.5line 34 to line 35);

- in response to the step of extracting:

- assembling a message packet containing the product information (Fig.1 Item 48, and 46), transmitting the message packet (i.e. using PPP or HTTP protocol) to an intermediate node (i.e. service provider) (Fig.1 Item 22) on the network (Fig.1 Item 20), receiving from the intermediate node (i.e. service provider) (Fig.1 Item 22) on the network instructional code that instructs the user node (Fig.1 Item 28) to connect to one of the remote nodes (Fig.1 Item 24) on the network (Fig.1 Item 20) that has defined association with the extracted product information

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defined at the intermediate node (Fig.5 Item 86, 88, and col.9 line 33 to line 43), and connecting the user node to the one of the remote nodes in accordance with the received instructional code such that connection to the remote location is controlled by the intermediate node through the instructional code (i.e. automatic jumping [connection] to desired location) (col.9 line 54 to line 65), wherein all connections to desired locations are controlled only by the intermediate node and not by any actions at the user node other than the operations of extracting (i.e. a field in database 60 for enabling the automatic diverting of the traffic to desired location) (col.9 line 33 to line 43), and wherein actions at the user node do not prevent connection or effect connection to the remote locations (col.9 line 54 to line 65).

3. Claims 2, and 8-9 are rejected as applied above in rejecting claim 1. Furthermore Hudetz teaches method of extracting product information (Fig. 1, 3, 5, and 8) wherein

- the product code is machine-readable code (col.6 line 29 to line 33),
- interfacing with the network utilizing network routing information embedded with instructional code (Fig.4-5, col.7 line 2 to col.8 line 10);
- transmitting the message packet comprises the step of:
 - transmitting the message packet containing the product code information to the intermediate node on the network (Fig.4 and col.7 line 2 to 16, and col. 8 line 17 to 47 and col. 9 line 14 to line 21);
 - comparing (i.e. matching) the product code information with an associative database (Fig.1 Item 60) having stored therein associations with a plurality of product code information

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and associated routing information and determining if there is a match (col.8 line 47 to col.9 line 21);

-if there is a match, returning instructional code embedded with the routing information to the location (Fig.1 Item 28) at which the product code information was extracted for assembling into the message packet (col. 8 line 4 to col.8 line 10, col. 10 line 45 to col. 11 line 39).

4. Claims 3-4 are rejected as applied above in rejecting claims 2. Further more Hudetz teaches and describes network routing utilizing product code, wherein:

- the step of extracting comprises scanning the machine-readable code to extract the product code information (col. 8 line 34 to line 46);

- and machine-readable code comprises a bar code (col. 10 line 3 to line 11, and col.11 line 28 to line 34).

5. Claims 5-7 are rejected as applied above in rejecting claims 4. Further more Hudetz teaches other formats and system for assigning product identification numbers such as UPC, ISBN and EAN (col. 6 line 34 to line 45).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 571-272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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December 30, 2004